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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/862,946 | 05/22/2001 | Nicolas Marie Pierre Godinot | IFF-17 | 9741 |

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| EXAMINER |
|---|
| OUELLETTE, JONATHAN P |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3629 | |

DATE MAILED: 01/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/862,946 | PIERRE GODINOT ET AL. | |
| | Examiner | Art Unit | |
| | Jonathan Ouellette | 3629 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *22 May 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 May 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

# DETAILED ACTION

## Claim Rejections - 35 USC § 101 and 35 USC § 112

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. An invention, which is eligible for patenting under 35 U.S.C. § 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a "useful, concrete and tangible result." The test for practical application as applied by the examiner involves the determination of the following factors:

   (a) "Useful" – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

      i. the utility need not be expressly recited in the claims, rather it may be inferred.

ii. If the utility is not asserted in the written description, then it must be well established.

(b) "Tangible" – Applying *In re Warmerdan*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. § 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "Concrete" – Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

4. Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Specifically:

5. In Claims 1-12, the ambiguities cited would make it impossible for the process to be repeatable or "concrete." In other words, different users would come up with different responses.

6. As per Claims 1-12, it appears that the method is attempting to sell a sensory perception service, whereas the service is dependent on independent criteria provided by subjects participating in the service. These independent criteria could contain a vast amount of

different setting combinations – which would include different settings for each of the following: subject's preference, subject's knowledge of subject matter being tested, subject's physical attributes, and the mainly subject's opinion. Thus, this method is not repeatable and would appear to be an attempt to patent an abstract idea not a "concrete" process.

7. Claims 1-12 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention lacks a patentable utility, for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term "emotional states" in claim 12 is used by the claim to mean "sensory perception," while the accepted meaning of sensory perception is: any of the faculties by which stimuli from outside or inside the body are received and felt, as the faculties of hearing, sight, smell, touch, taste, and equilibrium.

*Claim Rejections - 35 USC § 102*

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

12. Claim 1 are rejected under 35 U.S.C. 102(a) as being anticipated by Reading Scientific Services Ltd. (www.rssl.com, 4/10/2001).

13. As per independent Claim 1, RSSL discloses a method for visually presenting the attributes of a sensory perception comprising: (a) providing a subject; (b) providing the subject with a sensory perception scale on a computing device containing a plurality of attributes, said sensory perception scale having variable positions; (c) providing the subject with a test sample and requesting said subject to sample the test sample; (d) asking the subject to rate the attributes of the samples by manipulating the positions of the perception scale; and (e) providing the position of the variable position scale to a computing means, said computing means providing a visual interpretation on a screen of the attributes of the sample (www.rssl.com).

*Claim Rejections - 35 USC § 103*

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. Claims 2-12 are rejected under 35 U.S.C. 103(a) as being obvious over Reading Scientific Services Ltd..

16. As per Claims 2 and 3, RSSL fails to distinctly disclose wherein the visual interpretation of the attributes of the sample is provided as a pie chart / single bar chart.

17. However, RSSL does teach a visual interpretation of the attributes of the sample as part of a multi-axis chart (www.rssl.com), and the use of pie charts / single bar charts we well known at the time the invention was made.

18. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the visual interpretation of the attributes of the sample is provided as a pie chart / single bar chart, in the system disclosed by RSSL, for the advantage of providing a method for visually presenting the attributes of a sensory perception, with the ability to present the data in several chart formats in order to more clearly relay the information to the customer.

19. As per Claim 4 and 5, RSSL discloses wherein the relative value of each attribute is provided by a unique color (www.rssl.com).

20. As per Claim 6, RSSL discloses wherein the visual interpretation of the attributes of the sample is generated without having the subject perform any mathematical computation (www.rssl.com).

21. As per Claim 7, RSSL discloses wherein the sensory perception is taste (www.rssl.com).

22. As per Claim 8, RSSL discloses wherein the sensory perception is smell (www.rssl.com).

23. As per Claim 9, RSSL discloses wherein the sensory perception is visual (www.rssl.com).

24. As per Claim 10, RSSL discloses wherein the sensory perception is auditory (www.rssl.com).

25. As per Claim 11, RSSL discloses wherein the sensory perception is tactile (feel) (www.rssl.com).

***Conclusion***

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

27. The following patents are cited to further show the state of the art with respect to sensory evaluation in general:

**U.S. Pat. No. 5,941,833 to Lipman**

Lipman discloses a devices and method for determining a subject's cutaneous pain tolerance level at any site on the body so as to provide both for examiner and subject input as well as automatic data acquisition.

28. The following foreign patent is cited to show the best foreign prior art found by the examiner:

**Japanese Pat. No. JP 03294914 A to Sato et al.**

Sato discloses a taste sensitivity value sense axis classification chart and its generation method.

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.

31. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

jo
January 20, 2003

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600